

Appl. No. : 09/195,791
Filed : November 17, 1998

MASIMO.7CP1C5

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Mohamed K. Diab et al.
Appl. No. : 09/195,791
Filed : November 17, 1998
For : SIGNAL PROCESSING
APPARATUS
Examiner : Eric F. Winakur
Group Art Unit : 3768

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July 8, 2009

(Date)

John M. Grover, Reg. No. 42-610

REQUEST FOR RECONSIDERATION FOR DECISION ON

PETITION FOR PATENT TERM EXTENSION – SUSPENSION DELAY

Mail Stop PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request reconsideration of their Petition for Patent Term Extension according to the following comments.

Status

On April 4, 2008 and June 30, 2008, respectively, Applicants filed petitions under 37 CFR § 1.181 for correction of patent term ("the Petitions") in the above-identified application ("the Application"). The Petitions included a request for patent term extension under 35 U.S.C. § 154(b)(1) for delays due to interference proceedings. The arguments and responses presented in this Response supplement those presented in the Petitions.

On June 2, 2009, the Office of Patent Legal Administration ("the Office") mailed a decision on the Petitions ("the Decision"). The Office granted the first Petition in part, granting 191 days of patent term for the period from declaration of interference to the last day on which an appeal to the interference decision could be filed.

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The Office dismissed Applicants' request for:

(1) Termination Delay, which included an additional 19 days¹ of patent term extension for the time it took the Board of Patent Appeals and Interferences ("BPAI") to forward the application back to the Examiner for review; and

(2) Suspension Delay, which included an additional 246 days of patent term extension for delay caused by two Examiner initiated suspensions due to interference proceedings.

Remarks

Applicants respectfully disagree with the Office's dismissal of these requests and requests reconsideration of the Suspension Delay.

In the Petition, Applicants submitted that the patent term extension should be adjusted according to 37 C.F.R. § 1.701(c)(ii) by at least an additional 246 days because of two Examiner initiated suspensions.

In response, the Office states that extension is improper in this case according to § 1.701(c)(1)(ii) as there allegedly was no interference proceeding under 35 U.S.C. 135(a). Apparently, the Petitions Examiner would like to distinguish, for the basis of determining Patent Term Extension, between actual interference proceedings and potential interference proceedings, also known as suspensions.

Applicants submit that such a reading is not required under § 1.701(c)(1)(ii); rather, that § 1.701 should be read to include delay from actual and from potential proceedings when viewed in light of the statute.

35 U.S.C. § 135(a) recites:

(a) Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final

¹ The original request was for 80 days of delay from judgment in the interference proceedings to the date on which the case was sent back to the Examiner for review. However, because the Office granted the 61 days from judgment to the last day on which an appeal could be filed, the number has been adjusted to 19 days.

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judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

Accordingly, § 135(a) broadly establishes the statutory authority for the interference process, whether it be an actual declared interference or a suspension awaiting a declaration of interference. Indeed, § 135(a) forms the basis for Examiner-initiated suspensions of an application due to a potential interference, and such a suspension should therefore be deemed an "Interference proceeding under § 135(a)" pursuant to § 1.701(a)(1). Former § 154(b)(1), which forms the basis for § 1.701(a)(1), and should therefore be granted interpretational weight, also favors such a reading as it broadly states that extension should be granted for an "a proceeding under section 135(a) of this title."

Moreover, the length or duration of any delay due to suspensions is entirely within the control of the Office, as opposed to delay caused by or even governed by actions of the Applicants. As such, fairness dictates that such unilateral Office imposed delay result in additional term extension under the present Applicants' petitions.

Accordingly, Applicants respectfully request reconsideration on this issue and submit that the patent term extension should be adjusted according to 37 C.F.R. § 1.701(c)(ii) by at least an additional 246 days.

Summary

Applicants submit that the present application was delayed by at least 246 days in addition to the 191 days already granted by the Office. As such, the Applicants submit that the patent term extension should reflect the cumulative total of **437 days** of delay pursuant to 37 C.F.R. § 1.701 and request that the patent term extension be corrected to reflect at least this 437 day amount.

No fee is deemed due as none of 37 C.F.R. §§ 1.181, 1.182, or 1.701 indicate that a fee is due in conjunction with a request for reconsideration of a petition under 37 C.F.R. § 1.181 or § 1.182. However, in the event that a fee is due, please charge

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any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 2, 2009

By: 

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July 2, 2009

(Date)

John M. Grover, Reg. No. 42,640

REQUEST FOR RECONSIDERATION FOR DECISION ON PETITION FOR PATENT

TERM EXTENSION – TERMINATION DELAY

Mail Stop PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request reconsideration of their Petition for Patent Term Extension according to the following comments.

Status

On April 4, 2008 and June 30, 2008, respectively, Applicants filed petitions under 37 CFR § 1.181 for correction of patent term ("the Petitions") in the above-identified application ("the Application"). The Petitions included a request for patent term extension under 35 U.S.C. § 154(b)(1) for delays due to interference proceedings. The arguments and responses presented in this Response supplement those presented in the Petitions.

On June 2, 2009, the Office of Patent Legal Administration ("the Office") mailed a decision on the Petitions ("the Decision"). The Office granted the first Petition in part, granting 191 days of patent term for the period from declaration of interference to the last day on which an appeal to the interference decision could be filed.

The Office dismissed Applicants' request for:

- (1) Termination Delay, which included an additional 19 days¹ of patent term extension for the time it took the Board of Patent Appeals and Interferences ("BPAI") to forward the application back to the Examiner for review; and
- (2) Suspension Delay, which included an additional 246 days of patent term extension for the time incurred by two Examiner initiated suspensions due to interference proceedings.

Remarks

Applicants respectfully disagree with the Office's dismissal of these requests and requests reconsideration of the Termination Delay.

In the Petition, Applicants submitted that the patent term extension should be adjusted by at least an additional **19 days** for the time it took the BPAI to forward the case to the Examiner following the interference.

In response, the Office cites to 37 C.F.R. § 1.661 for the proposition that the interference should be considered terminated under 37 C.F.R. § 1.701(c)(i) two months after judgment when no appeal or other review could be taken, and not upon dispatch of the application back to the Examiner. Applicant notes that 37 C.F.R. § 1.661 does not appear to be in the current version of the C.F.R. Moreover, in a June 18, 2009 decision on a similar 37 C.F.R. § 1.181 Petition filed in related U.S. Application No. 09/144,897, the Office cited to 37 C.F.R. § 41.205(a) in support of the arguments made by the Petitions Examiner in the present case.

Unlike 37 C.F.R. § 1.661, 37 C.F.R. § 41.205(a) is a narrowly applicable subsection entitled "Constructive notice; time for filing," and is contained in § 41.205 of the C.F.R. entitled "Settlement Agreements." The definition of the term "termination" provided in such a narrowly applicable context should not be read to apply more broadly to the patent term extension context. Moreover, as noted in the Applicants' Petitions, the plain language of the applicable statute, former 35 U.S.C. § 154(b), and the applicable regulation, 37 C.F.R. § 1.701, indicate that patent term extension should be allowed for extension of patent term if the issuance of a patent is "delayed *due to*"

¹ The original request was for 80 days of delay from judgment in the interference proceedings to the date on which the case was sent back to the Examiner for review. However, because the Office granted the 61 days from judgment to the last day on which an appeal could be filed, the number has been adjusted to 19 days.

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interference proceedings. These portions of the applicable statute and regulation should be granted greater interpretational weight than § 41.205. Clearly the delay at issue here was *due to* interference proceedings as it would not have occurred absent the interference.

Moreover, the length or duration of any delay due to the failure to promptly forward the application to the Examiner for review is entirely within the control of the Office, as opposed to delay caused by or even governed by actions of the Applicants. As such, fairness dictates that such unilateral Office imposed delay result in additional term extension under the present Applicants' petitions.

Based on at least the foregoing, "Termination" as used in 37 C.F.R. § 1.701 should therefore be read to include such delay caused by the USPTO and directly related to the interference process. Accordingly, Applicants respectfully request reconsideration on this issue and submit that the patent term extension should be adjusted according to 37 C.F.R. § 1.701(i) by at least an additional 19 days.

Summary

Applicants submit that the present application was delayed by at least 19 days in addition to the 191 days already granted by the Office. As such, Applicants submit that the patent term extension should reflect the cumulative total of at least **210 days** pursuant to 37 C.F.R. § 1.701 and request that the patent term extension be corrected to reflect at least this 210 day amount.

No fee is deemed due as none of 37 C.F.R. §§ 1.181, 1.182, or 1.701 indicate that a fee is due in conjunction with a request for reconsideration of a petition under 37 C.F.R. § 1.181 or § 1.182. However, in the event that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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Respectfully submitted,

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Dated: July 2, 2009

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